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10/713,446

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Kenneth A. Walker JR.

03-025

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08/17/2006

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EXAMINER

WOODS, ERIC V

ART UNIT

PAPER NUMBER

2628

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/713,446

Applicant(s)

WALKER ET AL.

Examiner

Eric Woods

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,11,13-17 and 21-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,11,13-17 and 21-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Response to Arguments***

Applicant's arguments, see Remarks pages 1-8 and claim amendments, filed 18 May 2006, with respect to the rejection of all claims under 35 USC 103(a) have been fully considered and are found to be persuasive.

Therefore, the rejection of claims 1, 3-7, 11, 13-17, and 21-34 under 35 USC 103(a) have not been withdrawn.

Examiner has clarified and restated certain portions of the grounds of rejected and added new rationale, but has not changed the grounds of rejection.

Examiner thanks applicant for shifting to more precise language by replacing "image area" with "image container", which will be construed as having the definition found in the instant specification. An image container is a portion or region of a template that an image is associated with, where clearly the regions of Noda (Figs 9A-9F, 10A-10D), Roses (Figs 5-8), and the like constitute 'image containers', since they serve as placeholders within a template for such images. As noted in the Remarks and in the instant specification [0023], an image container constitutes – as an example – a background image area and a smaller image area, as in Figure 3, which corresponds perfectly with the templates of Noda, Roses, and the like.

It is pointed out that applicant's claims only require that the template be provided to the user at some point. The user could select the product, select the template, and then designate the images, at which point it would read on the instant claimed process. Applicant states on pages 1-2 of Remarks that the instant claims are not directed to a

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method of generating an electronic product and the like. The references applied may do so, but this is not their only function. They have at least the claimed processes, although they may have other steps that the instant application does not address.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., re-cropping a base image and the like) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). There is no discussion in the claims that the image must have been cropped beforehand. The claim only recites and requires that the image have been associated with the image container. Therefore, it is entirely plausible that the cropping recited therein could be the first cropping and not a subsequent one.

It is recommended that applicant amend the claims to include that limitation.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3-7, 11, 13-17, and 21-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roses in view of Noda and Haeberli.

As to claim 1,

A computer-implemented method for facilitating user customization of the image content of an image container in an electronic product design, the method comprising: (Roses [0068] stating the method is computer-implemented, Fig. 1 clearly shows a document composition website 110 that is connected to a customer photo web site 115 and general web site 120 for obtaining photos and images for obtaining image content for insertion into a document (see Fig. 2, where the images are put into an image basket) and such documents and their templates are shown in Fig. 5, with an image editing step shown in Fig. 6 with cropping capabilities as shown and in [0037,0043,0048])(Noda clearly shows electronic product designs, as in the templates shown in Figures 10A-10C and the like)

-Displaying an electronic product design to a user, the design containing at least one or more user-customizable image containers, each image container having content that is at least a portion of a base image associated with the image container; (Roses shows an electronic document or product design in Fig. 5, with the image areas shown in Fig. 6 and allowing the user to manipulate them – see [0028] for posters, Fig. 10 shows as item 1021 and next to it, that a “Year 2001 Calendar Type” can be chosen as a template, thus illustrating another type of document template, the document creation

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module / tool of Roses is shown in Fig. 2 as element 206, which is facilitated by the document creation / storage module 306 in Fig. 3 – see [0032-0033], where Roses teaches that documents have areas for fixed images (e.g. images with a fixed size, thus requiring cropping as in Fig. 6). Further, in [0047], it is taught that templates can have modifiable images, e.g. images that can be modified by the user, wherein the fixed images consist of images of a given size for insertion into a block, where in [0048] it is taught that the fixed images are clearly modifiable, since they can be cropped, filter, moved (location), et cetera)(Haeberli clearly teaches a 'product' (1:25-35; 2:10-3:20), where the user is presented with the ability to select various types of product, inclusive of ones where the final image placement is dependent upon the user's cropping of the base image (3:25-4:25, Figure 9b), see also Figures 8A-8B, 13:1-25, where the user can specify product orientations and details (diptych), and can put two images in one frame (for example); note also Figures 12a-12b, where the user can change the overall area and print size))(User selects the image as input in Noda [0052], and further Noda allows the user to select the inner area where the image will be inserted from a template [0002,0024], and in Figs. 9A-9F and 10A –10F where various layouts of photos for albums, etc. are shown. Further, these areas exist and may have a base size [0077-0078], as is known in the art (e.g. L-size, etc.) However, the user can set the size of these areas to a certain extent [0082-0085] by modifying the crop boundaries within the image, and also within Figures 10A-10D various other templates are shown, where the user could for example change the positions of the components of the template, and pick which template was desired, and choose from a variety of them [0078-0079])

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-Allowing the user to select an image container in the electronic product design for customization of the content of the image container, and (Roses [0047-0048] wherein there are modifiable images in the template that the user can customize, and also the fixed images can be customized by allowing the user to choose the image)(Haeberli clearly teaches that the user can select the desired portion of the window – see cropping window 9b, and also the Abstract. See where it states 'When a user changes the current selected portion of the image (for example, by actuating a control included in the user interface), a new crop mask can be generated based on the changes made by the user'). Clearly, this constitutes customization, and comprises' allowing the user to select an image area for customization of the content of image area. Also, note Figures 17a-17b, 14, where the user can change the borders, text, and the like, which would clearly constitute 'allowing the user to select an image area for customization')(User selects the image as input in Noda [0052], and further Noda allows the user to select the inner area where the image will be inserted from a template [0002,0024], and in Figs. 9A-9F where various layouts of photos for albums, etc. are shown, and finally in [0042-0043] it is taught that the user can select and customize the placement of text and images in modifiable areas)

-In response to a user request to perform custom cropping for the selected image container, displaying to the user (Haeberli clearly teaches that the user can elect to perform cropping on the image (see above, Figure 9b, 13:25-14:30), see the toolbar above, where there are options for 'Crop, Rotate, Effects, Borders' and the like)

-The associated base image, and (Roses Fig. 6 and [0043-0044], where the image is displayed in the section 611 for example, and the user can preview the document so in area 602 whilst editing it here)(Haeberli Figure 9b, which shows the base image – that is, the selected portion of the image 904 is shown)(Noda Fig. 3 where the image is displayed in area 46, and the user selects which image to show [0052] in the full size)

-A cropping indicator positioned to indicate to the user the portion of the base image that is the current content of the image container. (Haeberli Figure 9, clearly shows cropped area 904 in Figure 9b, where the cropping indicator is positioned to indicate the area that will be cropped, where the user can (13:25-14:30) change the shape of the cropping area, move it around, and otherwise alter it to their specification.)(Cropping indicator 84 in Noda Fig. 3 as discussed in [0081] is fit to the selected paper size or template spot)

Roses teaches most of the limitations of the stated claims, but does not teach showing the user the cropping indicator and the ability to modify to perform custom cropping. Reference Noda teaches most of these limitations, and explicitly teaches the use of customizable images and templates, and a manipulable cropping tool. Obviously the references are directed to a similar problem solving area and are analogous art, as both deal with inserting images into document templates and manipulating them, but Noda does not expressly teach custom cropping of the type shown by applicant.



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Haeberli teaches the limitation of allowing the user to modify the portion of the base image in the current image area by adapting the cropping indicator to match the shape of the region and the like.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the system of Roses with that of Noda because the system of Noda clearly allows for more effective cropping of images to fit in templates as set forth in the paragraphs above, especially since Roses does not show how the images are cropped per se or if the user is able to expressly choose the desired portion of an image to go in the template, and further Noda allows more options as far as customizing images such that when the image customization process is complete, multiple images could be combined into one and put into the documents of Roses (Figs. 4-6) or Noda (Figs. 10A-10D), which would prima facie allow for greater flexibility in how the user can manipulate the documents, as shown in Noda, which is beneficial.

In the Haeberli patent, the user issues the request for custom cropping and modifies the custom area as desired. Additionally, Haeberli allows the user to undo crops and other image changes to allow the user to customize the image area as desired. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Roses/Noda system to allow cropping of images in an online system for product ordering, since Haeberli allows the user to modify such images and does not "forget about the base image" since the user has uploaded the various images to the Shutterfly website in the first place, which clearly therefore means that they will in residence on the website. The Shutterfly service is expressly

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provisioned to allow users to create desired end products from basic digital photographs previously uploaded to the website. Motivation is found in 6:10-50, where the user's modification history is stored so that the user can log back into the site and continue modifications as if no time had elapsed, and other similar improvements shown therein.

As to claim 11, Applicant invokes means-plus-function language in claim 11. Clearly, the recited means disclosed by the references would be equivalent to that of applicant. The rejection to claim 1 is incorporated by reference. For example, the customization capabilities of the Roses reference in Figs. 4-7 and as taught in [0042-0043], where templates can be edited and have specific areas and layouts, as does Noda, for example in Figs. 9A-9F, and even more so in Figs. 10A-10D where the user can configure the locations of the various regions that are superimposed, which clearly provides the functionality recited by applicant in the specification and shown in for example Fig. 3. In Fig. 4 of the instant application, where the user can change cropping of an image, the user clearly can make those choices as shown in Fig. 6 of Roses and Figs. 3-5 and 11-13 of Noda, and the user can switch between images as shown with the navigation buttons on the Roses reference in Fig. 3 in the image chooser box, and Noda also allows modification in that manner. Clearly the image modification system of applicant shown in Figs. 5-9 of the instant application corresponds to the system of Noda in Fig. 3, with the manipulable cropping areas and boundaries (see element 84) and further in [0081-0084] Noda reveals that the crop boundary may be changed in size so as to correspond to the capabilities of applicant's recited invention. In the Haeberli

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patent, the user issues the request for custom cropping and modifies the custom area as desired. Additionally, Haeberli allows the user to undo crops and other image changes to allow the user to customize the image area as desired.

Clearly, all three systems are software, and it is well known in the art that any piece of software functionality can easily be implemented on another (same look and feel) in a manner where the functionality is alike yet uses completely different code to do so. Therefore, the software functionality is concomitant under the doctrine of functional equivalence. As such, the means plus function limitations under 35 U.S.C. 112, sixth paragraph, have been met, and examiner has met the burden to prove a *prima facie* case of equivalence between the recited elements. The rejection of claim 1 is incorporated by reference in its entirety for all other limitations not expressly described above and for motivation and rationale.

As to claims 33 and 34, Haeberli clearly teaches a computer-readable medium containing such a program, and a computer system to execute it, in 23:22-24:22 and Figure 19. These are merely notoriously well known variants of means of storing and executing the method of claim 1. Further, the computer system of Haeberli in Figure 19 has a central processor 1921. The other references also implicitly teach this limitation but do not do so expressly. Motivation and rationale are taken from the rejection to claim 1

As to claims 3 and 13, as set forth in the rejection to claim 1, Noda allows the user to change the size, position, and other aspects of the cropping boundary, which is *prima facie* equivalent to the cropping indicator [0083-0084], clearly this is done relative

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to the base image, where the base image is shown on the screen and the cropping indicator is altered relative to the base image as desired by the user. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 4 and 14, Noda clearly sets forth in [0082-0083] that the user cannot change the aspect ratio (e.g. the width to height ratio) even though the size can be in certain embodiments. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 5 and 15, the system of Roses allows the user to view the image in the preview window 602 of Fig. 6 when the image has been selected and scaled and/or cropped to fit, or manually filtered – see Fig. 6 and [0043-0044], and so it is updated, and the user can also do so at any time by hitting the preview button. Further, motivation or combination is taken from the rejection to the parent claim and herein incorporated by reference. Updating an image upon modification in the preview window is also prima facie obvious.

As to claims 6 and 16, the user can prima facie move the crop boundary / indicator around the base image in Noda as taught in [0081] and as shown in Fig. 3 for example. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 7 and 17, the system of Roses allows the user to view the image in the preview window 602 of Fig. 6 when the image has been selected and scaled and/or cropped to fit, or manually filtered, or the cropping window has been repositioned or moved (see Noda [0081—0082]) – see Fig. 6 and [0043-0044], and so it is updated,

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and the user can also do so at any time by hitting the preview button. Updating an image upon modification in the preview window is also prima facie obvious. Motivation and combination is taken from the parent claim and incorporated by reference herein. Also see the discussion in the rejection to claim 5 above, which is incorporated by reference.

As to claims 21 and 26, the Noda reference very clearly teaches that the user can open a template and that the system can automatically insert an image that is scanned into the first field in the template, which clearly would constitute the recited limitation – e.g. the computer would automatically selected the base image associated with the selected image area – see [0051-0057], Noda. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 22 and 27, the Noda reference very clearly teaches that the user can select a thumbnail of an image to put into a template [0051-0057], and clearly in Figure 7 the crop boundary takes the shape and size of the template, but can be altered by the user. In any case, the system of Noda can automatically select a portion of the image to crop and display in the template (e.g. centered crop [0051-10062]), which constitute the user not selecting the portion shown initially in the template as recited in the instant claim. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 23 and 28, obviously Roses allows the user to manipulate the size of the template areas [0037], where their location is independent of each other. Further, Noda teaches that templates (e.g. Figures 10A-10D) may have overlapping images, so

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very clearly it would be obvious that the various images or portions of the template would be independent of each other since Roses allows the user to control all aspects of the template per se. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 24 and 29, Noda clearly teaches that various templates can be shown to a user to allow the user to select the desired template [0080 specifically, [0078-0082 generally]], and Noda teaches selecting various images via thumbnail in [0055-0057] for example, where it would be obvious that if the user can select from amongst a plurality of visual templates, that thumb nailing the templates would be an obvious expedient to speed the selection process, since Noda does so for images explicitly and implicitly would do so since the plurality of templates would be visible to the user to select from, and this modification (if required) would have been obvious. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 25 and 30, obviously the user is allowed to select the image that goes into a particular template area [0055-0057 for examples]. It would be obvious that the user could choose another image to put into the image area depending on their tastes and preferences, since the association between images and base areas is preserved and not made permanent until an output document is created, e.g. a photograph album page is printed, and the like. Noda and Roses both allow the user to change the desired image. Motivation and combination is taken from the parent claim and incorporated by reference herein.

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As to claims 31 and 32, Haeberli 1:55-2:6 clearly teaches that online photo shops are available where the user can manipulate the image on the web and then have it printed and mailed to them. Therefore, this is an obvious expedient for the reasons described therein, and constitutes 'forwarding the product design to a printer for printing', where a 'printer' would constitute a printing device at an on-line photo finisher (e.g. the provider of Shutterfly, the Haeberli patent, etc).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Woods whose telephone number is 571-272-7775.

The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ulka Chauhan can be reached on 571-272-7782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Eric Woods

August 8, 2006

  
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